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EXAMINER
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NGUYEN, DUSTIN

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 02/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/965,655

Applicant(s)

BOUTHORS ET AL.

Examiner

Dustin Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 09/27/2001.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

1. Claims 1 – 33 are presented for examination.

### *Priority*

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in France on 09/29/2000. It is noted, however, that applicant has not filed a certified copy of the 0012494 application as required by 35 U.S.C. 119(b).

### *Double Patenting*

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-33 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of copending

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Application No. 09/965,674 [ hereinafter '674 application ]. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

Taking claim 1 as an exemplary claim, the '674 application contains the subject matter claimed in the instant application. As per claim 1, both applications are claiming common subject matter, as follows:

Consultation optimisation method ..., characterised in that it comprises:

an on-the-fly insertion ...,

in that the area ..., and

in that said active code ...

The claim of '674 application do not specifically state the method in the same order steps as described in the claim 1 of the instant application but it would have been obvious to a person skill in the art to recognize that the two claims are similar because it would have enable to provide additional information to user upon user's request.

As per independent claims 31 and 32, they are also directed to the same subject matter recited in claim 1 above. Accordingly, they are provisionally rejected under the judicially created doctrine of obviousness-type double patenting.

As per dependent claims 2-30 and 33, they contain similar subject matter as dependent claim of '674 application. Accordingly, they are provisionally rejected under the judicially created doctrine of obviousness-type double patenting.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 12, 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. The claim language in the following claims is not clearly understood:

I. As per claim 12, "at least criterion" on line 2 is not clearly explained.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-22, and 28-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Angles et al. [ US Patent No 6,385,592 ], in view of Landsman et al. [ US Patent No 6,314,451 ].

9. As per claim 1, Angles discloses the invention substantially as claimed including consultation optimisation method for a data page consulted on at least one terminal by at least one user, said page being downloaded from a first remote site via a communication network, characterised

in that said active code inserted on the fly is an intermediate invocation active code, which, when run by said terminal, enables said terminal, during an invocation step, to invoke a final active code provider, so that the terminal receives from said provider a specific final active code enabling the running of an algorithm on said terminal [ Figure 4; col 7, lines 65-col 8, lines 18; and col 18, lines 47-col 19, lines 23 ].

Angles does not specifically disclose

in that it comprises an on-the-fly insertion step of at least one active code in said page by at least one component of the architecture of said network,

in that the area of said page wherein said active code is inserted is determined according to the type of action generated by said active code.

Landsman discloses

in that it comprises an on-the-fly insertion step of at least one active code in said page by at least one component of the architecture of said network [ 40, Figure 2A, 210, Figure 2B; and col 17, lines 39-col 18, lines 39 ],

in that the area of said page wherein said active code is inserted is determined according to the type of action generated by said active code [ col 19, lines 47-65 ].

It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Angles and Landsman because Landsman's teaching of on-the-fly insertion of active code would allow to overcome the deficiencies associated with conventional web-based interstitial advertising techniques [ Landsman, col 9, lines 49-54 ].

10. As per claim 2, Angles discloses communication network is an Internet type network [ 33, Figure 2 ].

11. As per claim 3, Angles discloses at least one component of the architecture of said network belongs to the group comprising: Internet site host servers, access provider equipment, service provider equipment, routers, switches, gateways, and proxies [ 34, Figure 2; and col 1, lines 31-34 ].

12. As per claim 4, Angles discloses active code inserted on the fly is a final active code used to run an algorithm on said terminal [ col 16, lines 13-24 ].

13. As per claim 5, Angles discloses during said invocation of the final active code provider by said terminal, the terminal also provides at least one cookie [ col 11, lines 12-24 ].

14. As per claim 6, Angles discloses at least one step prior to said on-the-fly insertion step and belonging to the group comprising: steps consisting of rerouting an access of said terminal to the final active code provider, steps consisting of defining a profile of the user of said

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terminal, steps consisting of generating said at least one cookie as a function of the user profile of said terminal, steps consisting of provision of said at least one cookie by the final active code provider to said terminal, and steps consisting of storage of said at least one cookie by said terminal [ i.e. profile ] [ Abstract; and col 8, lines 19-30 ].

15. As per claim 7, Angles discloses at least one cookie is used for identification purposes [ col 7, lines 1-5 ].

16. As per claim 8, Angles discloses final active code provider takes into account of the content of said at least one cookie to generate the specific final active code [ col 11, lines 10-14; and col 19, lines 6-24 ].

17. As per claim 9, Angles discloses active code belongs to the group comprising: script codes interpreted by a browser, script code "includes" interpreted by a browser, browser objects, browser object operations, applets, applet operations, and macro-instructions [ i.e. plug-in ] [ col 7, lines 7-18 ].

18. As per claim 10, Angles discloses active code inserted in said page is loaded and/or interpreted and/or run by said terminal before, during and/or after the display of said page on said terminal [ col 6, lines 44-49 ].



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19. As per claim 11, Angles discloses active code is run in a browser comprised in said terminal [ col 9, lines 23-25 ].

20. As per claim 12, Angles discloses active code is generated specifically as a function of at least criterion specific to a component belonging to the group comprising: said at least one user of said terminal, said terminal, said first remote site, said page, the components of the architecture of said network, and the browser used by said terminal [ Figure 4 ].

21. As per claim 13, Angles discloses at least one criterion belongs to the group comprising: the identity of said at least one user of said terminal, the preferences of said at least one user of said terminal, the address and/or domain name of said first remote site, the address of said downloaded page, the browser type and/or version used by said terminal, the type and/or version of said terminal, the transfer protocol used to download said downloaded page, and the Internet access provider (IAP) or service provider (ISP) enabling said terminal to access said first remote site [ i.e. unique member code ] [ col 11, lines 10-14 ].

22. As per claim 14, Angles discloses at least one application belonging to the group: insertion, in said page, of information, particularly advertising, insertion, in said page, of information, particularly advertising, as a function of the content of said page, insertion, in said page, of information relating to events handled by a second remote site connected to said network, insertion, in said page, of information relating to data available on a portal in relation to the content of said page, provision to the user, via said page, of at least one service

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provided by at least one third remote site connected to said network, archival of information related to the activity on said network of the user of said terminal, modification of the presentation of said data, censoring of at least one data item in said data, and invocation of at least one second active code [ Figure 4 ].

23. As per claim 15, Angles discloses at least one application for the insertion in the page of additional information, and in that the active code implements the following operations: search for at least one specific information item in said page, creation of a list of specific information found in said page, creation of an additional information insertion field in said page provision of said list of specific information to an information provider connected to said network, and filling of said additional information insertion field with the data provided by said information provider in response to said specific information list provision operation [ col 19, lines 64-67 ].

24. As per claim 16, Angles discloses additional information belongs to the group comprising: advertising information, annotations, additional links to remote sites discussing the same subject as said downloaded page, additional links to remote sites discussing subjects related to the subject of said downloaded page, alternative key-words, notes assigned to said first remote site, and indexing tables for the components of said downloaded page [ Abstract; and col 15, lines 55-67 ].

25. As per claim 17, Angles does not specifically disclose at least one application modifying the presentation of said data; and in that said active code implements the following operations:

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search for at least one specific information item in said page, creation of a list of specific information found in said page, provision of said list of specific information to an information provider connected to said network, and presentation of at least part of said downloaded data according to a format defined by the information provider in response to said specific information list provision operation. Landsman discloses at least one application modifying the presentation of said data; and in that said active code implements the following operations: search for at least one specific information item in said page, creation of a list of specific information found in said page, provision of said list of specific information to an information provider connected to said network, and presentation of at least part of said downloaded data according to a format defined by the information provider in response to said specific information list provision operation [ col 13, lines 55-67 ]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Angles and Landsman because Landsman's teaching of modifying data would allow to consistently display up to date information to user according to user's need.

26. As per claim 18, Landsman discloses at least one application to censor at least one data item in said data, and in that said active code implements the following operations: search for at least one specific information item in said page, creation of a list of specific information found in said page, provision of said list of specific information to an information provider connected to said network, and censoring of at least part of said downloaded data according to at least one criterion defined by said information provider in response to said specific information list provision operation [ i.e. download ] [ Abstract ].

27. As per claim 19, it is rejected for similar reasons as stated above in claim 15.

28. As per claim 20, Angles discloses at least one specific information item belongs to the group of information comprising: key-words, link addresses, addresses of added items in said downloaded page, and creation information on said downloaded page [ col 15, lines 55-67 ].

29. As per claim 21, Angles discloses at least one specific information item is updated according to a predetermined criterion [ col 20, lines 23-29 ].

30. As per claim 22, it is rejected for similar reasons as stated above in claim 13.

31. As per claim 28, Angles discloses on-the-fly insertion step is systematic or selective [ col 20, lines 30-38 ].

32. As per claim 29, Angles discloses the execution of said active code is interrupted when the user requests the display of a new data page [ i.e. select ] [ col 2, lines 8-16 ].

33. As per claim 30, Angles does not specifically disclose data page is composed of at least two sub-pages, said active code is included in each said sub-page. Landsman discloses data page is composed of at least two sub-pages, said active code is included in each said sub-page [ Figures 2A and 2B ]. It would have been obvious to a person skill in the art at the time the

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invention was made to combine the teaching of Angles and Landsman because Landsman's teaching of sub-pages would allow to integrate various information from multiple sources into the page so that more available information can be displayed to user for convenience viewing.

34. As per claims 31 and 32, they are rejected for similar reasons as stated above in claim 1.

35. As per claim 33, it is rejected for similar reasons as stated above in claim 3.

36. Claims 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Angles et al. [ US Patent No 6,385,592 ], in view of Landsman et al. [ US Patent No 6,314,451 ], and further in view of Hawkins et al. [ US Patent No 6,005,561 ].

37. As per claim 23, Angles and Landsman do not disclose at least one application for permanent provision to the user, via said page, of at least one service provided by at least one fourth remote site connected to said network, and in that said active code, when it is run by the terminal, declares said at least one service in said page. Hawkins discloses at least one application for permanent provision to the user, via said page, of at least one service provided by at least one fourth remote site connected to said network, and in that said active code, when it is run by the terminal, declares said at least one service in said page [ col 10, lines 46-59 ]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Angles, Landsman and Hawkins because Hawkins' teaching of

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provision services would allow to enhance the system to provide information according to individual's need.

38. As per claim 24, Hawkins discloses code enables the implementation by the terminal of an access menu to said at least one service [ col 11, lines 40-58 ].

39. As per claim 25, Angles does not specifically disclose at least one service belongs to the group comprising: simplified access services to information other than that contained in said page, simplified access services to search engines, simplified access services to advanced functions of a browser comprised in the terminal, external event monitoring services, and simplified access to at least one service available manually on the Internet and which requires at least one data input operation. Landsman discloses at least one service belongs to the group comprising: simplified access services to information other than that contained in said page, simplified access services to search engines, simplified access services to advanced functions of a browser comprised in the terminal, external event monitoring services, and simplified access to at least one service available manually on the Internet and which requires at least one data input operation [ col 25, lines 50-67 ]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Angles and Landsman because Landsman's teaching of advance functions would allow to reduce operation overhead and increase performance.

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40. As per claim 26, Angles discloses at least one service is attached to at least one event belonging to the group comprising: actions on a man-machine interface, and browsing events [ col 5, lines 63-col 6, lines 5 ].

41. As per claim 27, Angles discloses at least one service is attached to at least one mark-up language component [ col 6, lines 37-53 ].

42. A shortened statutory period for response to this action is set to expire **3 (three) months and 0 (zero) days** from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the application (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dustin Nguyen whose telephone number is (571) 272-3971. The examiner can normally be reached on flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached at (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dustin Nguyen

Examiner

Art Unit 2154

  
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